

REMARKS

The Examiner is thanked for the due consideration given the application. The specification has been amended to insert headings. A terminal disclaimer is being filed concurrently with this paper.

Claims 1-27 are pending in the applications. Claim 1 has been amended to include subject matter canceled from claim 2. The claims have also been amended to improve their language. Claim 27 is new and recites subject matter canceled from claim 1.

No new matter is believed to be added to the application by this amendment.

Double Patenting

Claims 1-26 have been provisionally rejected on the ground of non-statutory obviousness-type double patenting over claims 43 and 58-83 of copending application 10/580,155. This rejection is respectfully traversed.

A terminal disclaimer of copending application 10/580,155 is being concurrently filed.

This rejection is believed to be overcome, and withdrawal thereof is respectfully requested.

The Drawings

Figure 3 is objected to as having boxes that have not been labeled.

Figure 3 includes boxes that have been labeled with numerals such as 11, 14, 14', 21, etc. These numerals have been explained in the specification such that one of ordinary skill would clearly understand the drawing figures.

There is thus no need to add legends to the boxes in Figure 3 in order to clarify the understanding of the drawing.

Rejection Under 35 USC §112. Second Paragraph

Claims 1, 2, 4, 6, 11, 14-17 and 21 have been rejected under 35 USC §112, second paragraph as being indefinite. This rejection is respectfully traversed.

The comments in the Official Action have been considered, and the claims have been amended to be clear, definite and have full antecedent basis.

This rejection is believed to be overcome, and withdrawal thereof is respectfully requested.

Rejection Over PFEIFER et al.

Claims 1-26 have been rejected under 35 USC §103(a) as being unpatentable over PFEIFER et al. (U.S. Patent 5,929,597). This rejection is respectfully traversed.

The present invention pertains to a portable self-contained electric power tool that is illustrated, by way of example, in Figure 1 of the application, which is reproduced below.

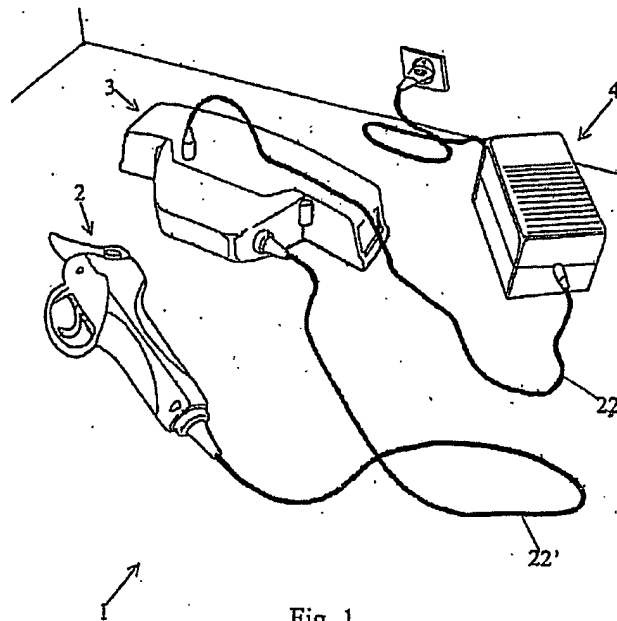


Fig. 1

Figure 1 shows a first subassembly forming an electrical actuator and generating the mechanical action of the tool; a second subassembly forming an electric energy source and comprising essentially a rechargeable electrochemical battery; and a third subassembly forming a charger adapted to carry out controlled recharging of the battery.

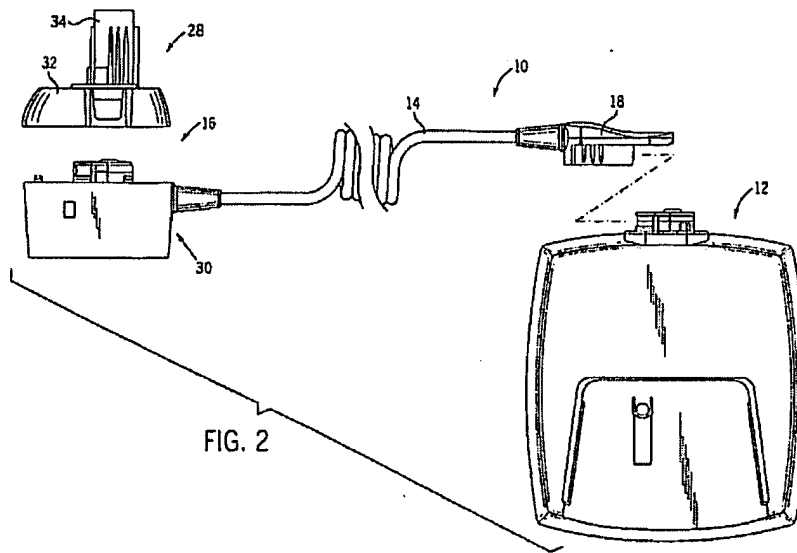
The second subassembly includes a control module (see Figures 3 and 4).

Claim 1 of the present invention recites:

the electrical command and control module (7) of the battery (5) fulfilling at least tasks i) to v) as follows:

- i) management of charge,
- ii) management of discharge,
- iii) balancing the charge of each cell (6),
- iv) protection in discharge of the battery (5) as to excess current during utilization of the tool, and
- v) management during storage.

PFEIFER et al. pertain to a portable electric power system to supply DC voltage. The Official Action refers to Figures 2-4 of PFEIFER et al. Figure 2 of PFEIFER et al. is reproduced below.



The apparatus of PFEIFER et al. is not a power tool in the sense of the present invention. Thus, in the PFEIFER et al., it is indicated (col. 3, lines 49-65) that the contemplated tool is of the piercing type without threads, whose battery block (normally integrated into the handle) has been replaced by a connector 34 adapted to engage in the adaptor block 16.

Moreover, in the system proposed by PFEIFER et al., the adaptor block 16 (which integrates a converter 36) is an indispensable element for PFEIFER et al., necessary to reduce the voltage supplied by the battery 13 to a lower voltage suitable

for the nominal voltage of the tool (see col. 2, lines 28 and 29). Such an adaptor is not provided in the power tool according to the invention.

Further, the systematic presence of the adaptor 16, necessary according to PFEIFER et al., substantially complicates the construction of the tool, renders this latter, heavier and more cumbersome and less manipulatable. There is, as a result, a complex mechanical and electrical connection at the level of the tool, which is manifested during the handling of this latter.

Concerning the battery (battery pack 12) forming a part of the system according to PFEIFER et al., there can be mentioned the following points:

- * the nature of the battery is not indicated (and hence no mention of Li-ion/Li-polymer, see claim 1 of the present invention);

- * the battery is not necessarily rechargeable;

- * the battery can have one or several cells 13 (no indication relating to the presence moreover of four cells in series as recited in claim 1 of our application) (see col. 3, lines 16-19 and Figure 3 of PFEIFER et al.).

Concerning the electronics for command and control, the following differences can be noted:

- * the microprocessor 40 (which the Official Action considers as being equivalent to the module 7 of claim 1 of the present invention) is not located immediately adjacent the

battery 13 (it is in fact located at the level of the adaptor 16, which is to say at a distance from the battery 13 - see Figure 4);

* the integrated circuit 40 is dedicated to the management of the converter 36 (see col. 4, line 67 to col. 5, line 3 of PFEIFER et al.) and hence does not fulfill the same functions as the module 7 of the invention;

* no device is provided which specifically fulfills the function of the system 8 according to the present invention.

Moreover, the characteristics of the passages cited by the Official Action as setting forth claim 2 of the present invention (see paragraph bridging pages 6 and 7 of the Official Action) fail to be equivalent to the functions carried out by the module 7 according to the invention as set forth in claims 1 and 2.

Additionally, the Official Action asserts that the when an element is "adapted to" perform a function, it does not constitute a limitation in any patentable sense.

A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971).

A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step. *Innova/Pure Water Inc. v. Safari Water Filtration Sys. Inc.*, 381 F.3d 1111, 1117-20, 72 USPQ2d 1001, 1006-08 (Fed. Cir. 2004).

Therefore, the functional limitations defined by language such as "adapted to" must be evaluated to what it means to one of ordinary skill. The functional language in the claimed present invention has not been subjected to such an analysis, but merely dismissed as to "not constitute a limitation in any patentable sense." Official Action at page 5, lines 16-17.

As a result, one of ordinary skill and creativity would fail to produce claim 1 of the present invention from a knowledge of PFEIFER et al. A prima facie case of unpatentability has thus not been made. Claims depending upon claim 1 are believed to be patentable for at least the above reasons.

This rejection is believed to be overcome, and withdrawal thereof is respectfully requested.

CONCLUSION

The Examiner is thanked for considering the Information Disclosure Statement filed May 19, 2006 and for making an initialed PTO-1449 Form of record in the application.

Prior art of record but not utilized is believed to be non-pertinent to the instant claims.

The objections and rejections of record are believed to have been overcome, obviated or rendered moot and that no issues remain. The Examiner is accordingly respectfully requested to place the application in condition for allowance and to issue a Notice of Allowability.

Please charge the fee of \$130 for the Terminal Disclaimer filed herewith, to our credit card set forth in the attached Credit Card Payment Form.

Please charge the fee of \$50 for the one claim of any type added herewith, to our credit card set forth in the attached Credit Card Payment Form.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment

to Deposit Account No. 25-0120 for any additional fees required
under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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APPENDIX:

The Appendix includes the following item(s):

- ☒ - a terminal disclaimer
- ☐ - a 37 CFR 1.132 Declaration
- ☐ - a new or amended Abstract of the Disclosure
- ☐ - a Replacement Sheet for Figure of the drawings
- ☐ - a Substitute Specification and a marked-up copy of the
originally-filed specification
- ☐ - a verified English translation of foreign priority document